



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/501,019	03/03/2005	Guillaume Sebire	879A.0030.U1(US)	3593
29683 7590 02/29/2008 HARRINGTON & SMITH, PC 4 RESEARCH DRIVE SHELTON, CT 06484-6212			EXAMINER BALAOING, ARIEL A	
			ART UNIT 2617	PAPER NUMBER
			MAIL DATE 02/29/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/501,019	Applicant(s) SEBIRE ET AL.	
	Examiner Ariel Balaoing	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --.

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 15-17 is/are rejected.
- 7) ☒ Claim(s) 14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's arguments, see page 5, filed 12/03/2007, with respect to the rejection(s) of claim(s) 1-8 under 35 U.S.C. 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Applicant's description of the prior art (see paragraph 6 of the background).

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 16 and 17 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Newly added claims 16 and 17 recite the limitation "a computer readable medium embodied with a computer program". However, the specification does not mention a computer readable medium or memory capable of embodying a computer program. It appears that "computer readable medium" may describe a system information 3 syntax which is non-statutory.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 16 and 17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Newly added claims 16 and 17 recite the limitation "a computer readable medium embodied with a computer program".

However, the specification does not mention a computer readable medium or memory capable of embodying a computer program. It appears that "computer readable medium" may describe a system information 3 syntax which is non-statutory.

6. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "at least one spare bit" in line 5 of the claim. Line 8 of the claim recites "said spare bit". It is unclear if the limitation refers to a single spare bit, or to one or more spare bits. For the rejections below, spare bit is used as "at least one spare bit" as recited on line 5.

Claims 2-8 are rejected for being dependent on an indefinite claim.

Claim Rejections - 35 USC § 103

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 1, 2, 8-13, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over MILDH et al (US 2002/0193139 A1) in view Applicant's description of the prior art.

Regarding claim 1, MILDH discloses a method for broadcasting of a possibility to use UMTS service **26** in a cell under control of a GSM/EDGE radio access network (GERAN) type radio access network **20, 24** having an Iu interface to a 3G core network **22**, a radio resource management system of the radio access network comprising a first and a second message, which messages are transferred on a first broadcast control channel in said cell [**BCCH**], and which first message has at least one spare bit, wherein said first message is System Information of GSM system, said spare bit is used for indicating whether said cell supports an UMTS service (paragraph 16, 21), and in a favourable case in which the GERAN controlled cell is determined to support the UMTS service, describing a second broadcast control channel [**PBCCH**] in the second message to at least Iu mobile stations (paragraph 22-33), and broadcasting UMTS service information for Iu mobile stations on the second broadcast control channel (paragraph 6, 8-10, 16-18). Although MILDH discloses the use of System Information type messages, MILDH does not disclose at least one spare bit, characterized in that said first message is system information 3 of GSM system. In the same field of the endeavor, Applicant's description of the prior art discloses a first message is a system information 3 of GSM system, said spare bit is used for indicating whether said cell supports an UMTS service (paragraph 6). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify MILDH to include at least one spare bit as disclosed by the applicant's description of the prior art,

since a proposal by Ericsson Ltd for adding a two bit field within a part of the SI3 message was known and would result in informing mobile stations about an lu service mode.

Regarding claim 2, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. MILDH further discloses said first channel being BCCH of the GSM system and said second channel being PBCCH of the GSM system (paragraph 19).

Regarding claim 8, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. MILDH in view of the applicant's description of the prior art further discloses said cell being barred against UMTS operation through lu interface by indicating with information that UMTS service is not supported in said cell (paragraph 11, 15-19).

Regarding claim 9, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. MILDH in view of the applicant's description of the prior art further discloses wherein said spare bit is located in a rest octet of the system information 3 message (MILDH – paragraph 16, 21; applicant's disclosure of the prior art – paragraph 6; MILDH shows the rest octet containing information distributed to mobile stations in the cell capable of lu support, while applicant's disclosure of the prior art show a spare bit used within a an SI3 message for providing lu support information).

Regarding claim 10, MILDH discloses an apparatus comprising: a controller having two or more service modes, where the controller wirelessly communicates to at least one wireless terminal an availability of at least one of the two or more service

modes through the use of a System Information message of a Global System for Mobile communications (GSM) system transferred on a first broadcast control channel, wherein an availability of one of the two or more service modes is indicated through a single spare bit in the first message (paragraph 16-21; paragraph 16 shows one bit used to select a 2G or 3G network in a SI/PSI message), and, if it is indicated that the one of the two or more service modes is available, then a second broadcast control channel through which service information of the one of the two or more service modes is to be broadcast is described (paragraph 18-32). Although MILDH discloses the use of System Information type messages, MILDH does not disclose the use of a System Information 3 message of a Global system for Mobile communication system. In the same field of the endeavor, Applicant's description of the prior art discloses a first message is a system information 3 of GSM system, said spare bit is used for indicating whether said cell supports an UMTS service (paragraph 6). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify MILDH to include at least one spare bit as disclosed by the applicant's description of the prior art, since a proposal by Ericsson Ltd for adding a two bit field within a part of the SI3 message was known and would result in informing mobile stations about an lu service mode.

Regarding claim 11, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. MILDH further disclose wherein the first broadcast control channel is a broadcast control channel (BCCH) of the GSM system (paragraph 18-21).

Regarding claim 12, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. The combination MILDH and the applicant's description of the prior art further disclose wherein the single spare bit is a spare bit in the SI3 rest octets (MILDH – paragraph 16, 21; Applicant's description of the prior art – paragraph 6).

Regarding claim 13, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. MILDH further disclose wherein the single spare bit is an lu support indicator (paragraph 16, 21).

Regarding claim 15, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. MILDH further disclose wherein the apparatus comprises a base station controller in a GSM/EDGE radio access network (GERAN) cell (paragraph 11, 14).

9. Claims 3-6, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over MILDH et al (US 2002/0193139 A1) in view Applicant's description of the prior art and further in view of ETSI 3GPP 04.18 v 9.0.

Regarding claim 3, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. MILDH further discloses the radio access network supporting the UMTS-service and not supporting a GPRS service, wherein said first message further comprises an lu indicator field (paragraph 6, 15-18). However, MILDH in view of the applicant's disclosure of the prior art does not expressly disclose wherein said second message is System Information 13alt of the GSM system and is legible only to lu mobile stations. ETSI 3GPP 04.18 v 9.0 discloses wherein a second

message is System Information 13 of the GSM system and is legible only to lu mobile stations (page 148, section 9.143a; page 244-245, section 10.5.2.26a). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify MILDH in view of the applicant's disclosure of the prior art to include the use of System Information 13, as taught by ETSI 3GPP 04.18 v9.0, since System Information 13 is a well known and conventional protocol used in GSM system to provide information related to GPRS within a cell (see page 148).

Regarding claim 4, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. MILDH further discloses the second channel being available also to the GPRS service (paragraph 6, 15-18). However MILDH in view of the applicant's disclosure of the prior art does not disclose wherein said second message is System Information 13 of the GSM system. ETSI 3GPP 04.18 v.9.0 discloses wherein a second message is System Information 13 of the GSM system (page 148, section 9.143a; page 244-245, section 10.5.2.26a). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify MILDH in view of the applicant's disclosure of the prior art to include the use of System Information 13, as taught by ETSI 3GPP 04.18 v9.0, since System Information 13 is a well known and conventional protocol used in GSM system to provide information related to GPRS within a cell (see page 148).

Regarding claim 5, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. MILDH further discloses the second channel being available also to the GPRS service (paragraph 6, 15-18). However MILDH in view of

the applicant's disclosure of the prior art does not disclose wherein said message System Information 13 is legible only to lu mobile stations and Gb mobile stations. ETSI 3GPP 04.18 v 9.0 discloses wherein said message System Information 13 is legible only to lu mobile stations and Gb mobile stations (page 148, section 9.143a; page 244-245, section 10.5.2.26a). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify MILDH in view of the applicant's disclosure of the prior art to include the use of System Information 13, as taught by ETSI 3GPP 04.18 v9.0, since System Information 13 is a well known and conventional protocol used in GSM system to provide information related to GPRS within a cell (see page 148).

Regarding claim 6, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. MILDH further discloses the second channel being not available to the GPRS service (paragraph 6, 15-18). However MILDH in view of the applicant's disclosure of the prior art does not disclose wherein a description of the second channel in the message System Information 13 is legible only to lu mobile stations. ETSI 3GPP 04.18 v 9.0 discloses wherein a description of the second channel in the message System Information 13 is legible only to lu mobile stations (page 148, section 9.143a; page 244-245, section 10.5.2.26a). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify MILDH in view of the applicant's disclosure of the prior art to include the use of System Information 13, as taught by ETSI 3GPP 04.18 v9.0, since System Information

13 is a well known and conventional protocol used in GSM system to provide information related to GPRS within a cell (see page 148).

Regarding claim 16, MILDH discloses a computer readable medium embodied with a computer program comprising: computer code for setting a lu support indicator in a system information message (paragraph 16, 21); computer code for determining if a general purpose radio system GPRS mode is supported and, if GPRS mode is not supported, describing a power broadcast control channel PBCCH in SI (paragraph 18, 23-28); computer code, if it is determined that the GPRS mode is supported, for determining if the PBCCH is available to the GPRS mode, if it is determined that the PBCCH is available to the GPRS mode, then describing PBCCH in SI for Gb and lu mobile terminals, otherwise, describing PBCCH in SI for lu mobile terminals only (paragraph 16-24, 35-38). Although MILDH discloses the use of System Information type messages, MILDH does not disclose setting a lu support indicator in a system information 3 message. In the same field of the endeavor, Applicant's description of the prior art discloses setting a lu support indicator in a system information 3 message (paragraph 6). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify MILDH to include setting a lu support indicator in a system information 3 message as disclosed by the applicant's description of the prior art, since a proposal by Ericsson Ltd for adding a two bit field within a part of the SI3 message was known and would result in informing mobile stations about an lu service mode. However, the combination of MILDH and the applicant's disclosure of the prior art does not disclose the use of SI13 messaging. In the same field of the

endeavor, ETSI 3GPP 04.18 v 9.0 discloses the use of SI13 messaging to provide GPRS information of a cell. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify MILDH in view of the applicant's disclosure of the prior art to include the use of System Information 13, as taught by ETSI 3GPP 04.18 v9.0, since System Information 13 is a well known and conventional protocol used in GSM system to provide information related to GPRS within a cell (see page 148).

Regarding claim 17, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. The combination of MILDH and the applicant's disclosure of the prior art further disclose wherein the lu support indicator is a single spare bit in a rest octet of the SI3 message (MILDH – paragraph 16, 21; Applicant's description of the prior art – paragraph 6).

10. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over MILDH et al (US 2002/0193139 A1) in view of the applicant's disclosure of the prior art and ETSI 3GPP 04.18 v 9.0 as applied to claim 3 above, and further in view of RAITH (US 5,930,706).

Regarding claim 7, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. MILDH further discloses said lu to transfer the second message (paragraph 6, 11, 15-18). However, MILDH in view of the applicant's disclosure of the prior art and ETSI 3GPP 04.18 v 9.0 does not expressly disclose an indicator field indicating whether normal BCCH or extended BCCH is used to transfer a message. RAITH discloses an indicator field indicating whether normal BCCH or

extended BCCH is used to transfer a message (paragraph 21, line 22-57). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination of MILDH in view of the applicant's disclosure of the prior art and ETSI 3GPP 04.18 v 9.0 to include an indicator field indicating whether normal BCCH or extended BCCH is used to transfer a message as taught by RAITH, since RAITH teaches that such a modification would allow a system to transmit information at various rates depending on importance.

Allowable Subject Matter

11. Claim 14 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ariel Balaoing whose telephone number is (571) 272-7317. The examiner can normally be reached on Monday-Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on (571) 272-7872. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Application/Control Number:
10/501,019
Art Unit: 2617

Page 13

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ariel Balaoing – Art Unit 2617

AB


WILLIAM TROST
SUPERVISOR, PATENT EXAMINER
TECHNOLOGY CENTER 2600